

**REMARKS**

Claims 1-6, 8-11, 20-39 and 41-52 are pending, with claims 1, 11, 30 and 50-52 being independent. Claims 7 and 40 have been canceled such that the limitations of these claims have been incorporated into claims 1, 11, 30 and 50-52. As such, claims 1, 11, 30 and 50-52 have been amended to further distinguish the present claims from the cited prior art, as discussed below. No new matter has been added. Thus, entry of the Amendment is respectfully requested.

**Claim Rejections – 35 U.S.C. § 101**

The Examiner rejected claims 1-10, 20-29, 50 and 53-54 under 35 U.S.C. § 101 for disqualifying as a statutory process by alleging that the claimed methods are not tied to another statutory class and can be performed without the use of a particular apparatus. Particularly, the Examiner, at page 3 of the Office Action, alleged that “Applicant’s method steps do not recite who or what is performing the method.”

Applicant respectfully traverses this rejection.

Regarding the method claims, they clearly require that each step of the claimed methods utilize a computer system by reciting “a computer system” for example in claim 1, lines 3, 10, 12 and 20 and in claim 50, lines 3, 12, 15, 22. Specifically, it should be noted that the present claims require that the storing step, the determining step, the presenting step and the generating step be performed by utilizing the computer system including a database, an input device and a display device.

Additionally, the present method claims require that each be performed by “using one or more modules,” for example in claim 1, lines 4, 9, 14 and 22 and in claim 50, lines 4, 7, 11, 16 and 26. Because these modules are stored in a computer memory, the claimed methods are tied to another statutory class. Furthermore, by reading the claims in light of the specification as required, Applicant respectfully submits that the Examiner’s rejection under 35 U.S.C. § 101 for the reasons set forth by the Examiner is improper.

Therefore, withdrawal of this rejection is respectfully submitted.

#### **Claim Rejections – 35 U.S.C. § 112**

The Examiner rejected claims 1-10, 20-29 and 50-54 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one of skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Particularly, the Examiner, at pages 4 and 5, alleged that the recitation of “a particular insurance plan had previously been unavailable” is new matter.

Applicant respectfully traverses this rejection. The support of the language added in the previous Amendment was previously explained and it is abundantly clear that the added language is supported in the present disclosure. Additionally, this language was discussed during the personal interview in an effort to clarify the claimed invention. However, in an effort to expedite prosecution, Applicant has deleted the language objected by the Examiner.

Additionally, claims 1 and 50-52 have been amended to recite “the particular insurance

plan being offered is not currently available” instead of “a particular insurance plan had previously been unavailable.” Support for this amendment is found, for example, in the determining step of claim 1 and in original claim 7. It is noted that during the personal interview, the Examiner indicated that she understood the differences between the claimed invention versus the disclosures of the cited prior art. Applicant has attempted to use claim language the Examiner would find acceptable. If the Examiner continues to find the present claim language objectionable, the Examiner is invited to call the undersigned and suggest language that the Examiner finds acceptable, in order to advance prosecution.

Accordingly, withdrawal of this rejection is respectfully requested.

**Claim Rejections – 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-11 and 20-54 under 35 U.S.C. § 103(a) as being unpatentable over Lockwood (U.S. Patent No. 4,567,359, hereinafter as “Lockwood”) in view of Warady (U.S. Patent No. 6,067,522, hereinafter as “Warady”) and further in view of Tyler (U.S. Patent No. 5,523,942, hereinafter as “Tyler”) for substantially the same reasons given in the prior Office Action of August 6, 2008.

Applicant respectfully traverses these rejections.

It is noted that Applicant has amended claims 1, 11, 30 and 50-52 to recite the following limitations: “presenting (or present) a description of insurance plan options, the options comprising an option currently available to the customer on the display device based upon the customer data and the user selected plan options by using the one or more modules, the description

of insurance plan options including an indication that a particular insurance plan being offered is not currently available to the customer, and an indication of what conditions are not met for the customer to qualify for the offered but currently not available insurance plan.” (emphasis added). The limitations of claims 7 and 40 have been added to these independent claims.

As such, **claim 1**, as amended, recites, *inter alia*, “**presenting . . . an indication what conditions are not met for the customer to qualify for the offered but currently not available insurance plan.**”

Regarding these limitations, the Examiner, at page 13 of the Office Action, did not apply the primary reference, Lockwood. Instead, the Examiner asserted that Warady, at column 4, line 51 to column 5, line 30; column 5, line 55 to column 6, line 11; and column 9, line 58 to column 10, line 8, discloses these limitations.

Particularly, the Examiner, at page 13 of the Office Action, stated:

Examiner interprets Warady’s teachings of “... [...] ... prerequisites table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that must be met before an employee can be enrolled in the plans. For example, certain life insurance plans require evidence of insurability of an employee to be approved by the plan provider before the employee is eligible to receive the chosen benefit or level of coverage. In this example, the prerequisites table 110 could store information describing the conditions under which evidence of insurability is required by the plan provider ... [...] ...” (Warady; column 5, line 65 to column 6, line 7) to teach a form of “wherein the indication that a plan has been determined to not be currently available to the customer comprises conditions which are not met for the customer to qualify for the offered but currently not available insurance plan;”

However, Warady, at column 5, line 65 to column 6, line 1, merely states “[t]he

prerequisite table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that must be met before an employee can be enrolled in the plans.” Further, Warady, at column 13, lines 20-22, merely states “[i]f the prerequisites are not approved, then ... the employee is denied the requested benefit.”

Warady simply discloses a health and welfare benefit **enrollment** and billing system and method (see Abstract), while the present application is drawn to a method for **generating a customized proposal** in the development of insurance plans for a customer. In other words, Warady’s method does not present a customized proposal, but merely **denies** or **approves** an employee’s application for a benefit based on the prerequisite conditions. All of the other above-cited passages also do not disclose these limitations.

Thus, Warady does not teach or suggest a method of **presenting a customized proposal including an indication of what conditions are not met** for the customer **to qualify for the offered but currently not available** insurance plan.

Further, claim 1 requires, *inter alia*, “**determining** if a particular insurance plan **may be offered but is not currently available** to the customer” as recited in the second paragraph of claim 1.

The Examiner, at page 9 of the Office Action, admitted that Lockwood does not disclose this limitation. Instead, the Examiner, at pages 9-11 of the Office Action, asserted that Warady, at column 4, line 51 to column 5, line 5; column 5, line 65 to column 6, line 7; column 8, lines 20-35; and column 9, line 58 to column 10, line 8 discloses this limitation above.

However, Warady, at column 5, line 65 to column 6, line 1, merely states “[t]he

prerequisite table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that must be met before an employee can be enrolled in the plans.” Also, Warady, at column 4, lines 52-56, merely teaches adding to a database information which can include “the benefit types and coverage options available to the employees for enrollment selection, identification of which benefits are employee selectable and which are attached to other employee selections.” It should be noted that all information that can be included in the benefit files are only related to the “benefit plans in which the employer’s employees can be enrolled.” See Warady at column 4, line 50-51. Furthermore, Warady, at column 13, lines 20-22, merely states “[i]f the prerequisites are not approved, then ... the employee **is denied** the requested benefit.”

As such, Warady’s method merely determines **if a prerequisite is met to deny or approve** an employment’s application for a benefit. So, if a requirement is not met, the enrollment application is denied, i.e., not be offered to the employee. In fact, Warady teaches away from determining **if a particular insurance plan may be offered** despite the fact that one or more requirements are not currently met. All of the other above-cited passages also do not disclose this limitation.

Thus, Warady does not teach or suggest **determining** if a particular insurance plan **may be offered but is not currently available** to the customer.

Further, claim 1 now requires, *inter alia*, “presenting . . . an indication that the particular insurance plan being offered is not currently available to the customer.”

Unlike the limitation of “determining if a particular insurance plan may be offered but is

not currently available to the customer,” this limitation requires **presenting an indication** that the particular insurance plan **being offered is not currently available** to the customer. Applicant respectfully submits that the combination of cited prior art does not disclose or suggest this limitation.

As discussed above, Warady’s method does not present a customized proposal, but merely **denies or approves** an employee’s application for a benefit based on the prerequisite conditions. As the environment of Warrady is very different from that of Lockwood, one skilled in the art would not look to Warrady’s alleged teachings to modify Lockwood in the manner suggested by the Examiner. Additionally, because of this Warrady does not even disclose or suggest creating a customized proposal, the alleged teachings of Warrady would not be combinable to the systems and methods of Lockwood.

Thus, Lockwood, Warady or any combination thereof does not teach or suggest presenting a customized proposal including “an indication that the particular insurance plan being offered is not currently available to the customer.”

Further, claim 1 recites, in part, “generating a customized proposal . . . the proposal including ... at least a portion of the customer data, and estimated costs.”

The Examiner, at page 8 of the Office Action, asserted that Lockwood, at Abstract, column 1, lines 20-36; column 1, line 45 to column 2, line 60; column 3, lines 9-48; column 5, line 65 to column 6, line 32; column 7, lines 5-24; column 7, line 60 to column 8, line 2; and column 9, lines 13-30, discloses this limitation.

However, Lockwood, at column 7, lines 10-13, merely states “[t]he central data processing center performs the desired quote, as will be described in connection with FIG. 6 below, and sends the quote back to the terminal.”

Lockwood merely teaches creating a quote for an insurance plan, but it does not disclose including a portion of the customer data into the customized proposal. All of the other above-cited passages also do not disclose this limitation.

Thus, Lockwood does not teach or suggest “generating a customized proposal ... the proposal including . . . at least a portion of the customer data.”

Additionally, claim 1 recites, in part, “wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal.” The present specification, at page 8, lines 3-7, discloses that “[t]he preliminary proposal generator module 205 takes the plan produced by the plan configuration engine module 204 along with cost data to prepare a formal proposal to the customer. This proposal may be in the form of a word processing document that may be saved and edited. It may also contain personalized graphics data to uniquely indentify the source of the proposal as well as the customer to whom it is being offered.”

The Examiner, at page 11 of the Office Action, asserted that Tyler, at column 4, lines 65 to column 5, line 40; and column 6, lines 58-65, discloses this limitation above.

However, Tyler, at column 6, lines 59, merely states “[t]he calculation engine of the present invention accesses required rates, performs all required calculations related to the proposal based on the information entered at the design grid, and returns the proposal output to the user.”

Applicant asserts that the calculation engine of Tyler may teach (which Applicant does not admit), at best, the plan configuration engine module, but it does not relate to the preliminary proposal module taking a plan produced by the plan configuration engine. While Applicant cannot import features disclosed in the specification into the claims, the Examiner is required to read the claims in light of the specification. Thus, when reading the claims in light of the specification, the Examiner cannot simply ignore the recited the “preliminary proposal module” or interpret it as any module. All of the other above-cited passages also do not disclose this limitation.

Thus, Lockwood does not teach or suggest the limitation of “wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal.”

Independent claims 11, 30 and 50-52 require similar limitations as recited in claim 1 such that claims 1-6, 8-11, 20-39 and 41-54 are patentably distinguishable from the applied prior art for the reasons stated above regarding claim 1.

Additionally, independent **claims 50-52**, recite, *inter alia*, “generating a customized proposal in the computer system **that is different from the stored insurance products.**”

The Examiner, at page 22 of the Office Action, asserted that Lockwood, at column 2, lines 47-60, discloses this limitation. Particularly, the Examiner stated that “generating a customized proposal in the computer system that is ‘extracted’ from stored information (reads on ‘different from the stored insurance products’).”

However, Lockwood, at column 2, lines 52-55, merely states “[i]n response to the gathered information, the central data processing center extracts **the desired information from its storage** and transmits it back to the terminal where it is relayed to the customer.” Further, Lockwood, at column 7, lines 5-13, merely states “Once all the necessary information has been gathered at the terminal (see 44), the processing unit 14 auto-dials the central data processing center 1 (see 45, FIG. 5), sends the gathered information to the center (46) and waits to receive an insurance quotation from each participating company. The central data processing center performs the desired quote, as will be described in connection with FIG. 6 below, and sends the quote back to the terminal.”

As such, the phrase “extracts the desired information from its storage” merely teaches extracting information from the storage needed to present **an insurance quotation** to a customer.

Thus, the phrase “the central data processing center extracts the desired information from its storage” is too remote to teach or suggest “generating a customized proposal in the computer system **that is different from the stored insurance products.**”

Thus, it is respectfully submitted that claims 50-52 are patentably distinguishable from any applied prior art in any case.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims herein are respectfully requested and now believed to be appropriate.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be

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exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Should the Examiner have any questions or comments regarding this matter, the undersigned may be contacted at the below-listed telephone number.

Respectfully submitted,  
Jerome D. JOHNSON et al.

A handwritten signature in black ink, appearing to read 'Abraham HersHKovitz', written over a horizontal line.

Abraham HersHKovitz  
Reg. No. 45,294

Dinh X. Nguyen  
Reg. No. 54,923

Jae Youn Kim  
L0485

August 13, 2009

HERSHKOVITZ & ASSOCIATES, LLC  
2845 DUKE STREET  
ALEXANDRIA, VA 22314

(703) 370-4800  
(703) 370-4809 (FAX)

AH/DXN/SK/SP/cgvr